

application into condition for allowance, entry thereof is respectfully requested as placing the application into better condition for appeal.

Off

Improper Finality of Outstanding Office Action

Applicants respectfully submit that the finality of the outstanding Office Action is improper. In the previous Office Action the Examiner provided legally insufficient rejections under 35 U.S.C. §112, second paragraph. For instance, the Examiner failed to shift the burden to Applicants as to (1) why the order of layers must be specified and (2) why the definition of "copolymer blend" must be clarified. The Examiner has now provided additional reasoning and argumentation concerning these issues. Thus, it is concluded that the Examiner has agreed that his previous rejections were legally insufficient, otherwise he would have simply maintained his rejections without further comment. Without conceding that the burden has been shifted, Applicants are only now being provided with the opportunity to respond to the Examiner's rejection. However, the finality of the outstanding Office Action denies Applicants the opportunity to respond to the rejection on the merits. This is improper.

Not  
air

Additionally, the Examiner has for the first time objected to the disclosure asserting that the anti-static layer (26) is not shown in Figure 1. Again, Applicants have been denied an

hot  
air

opportunity to respond to this issue on the merits.

Accordingly, the Examiner is respectfully requested to withdraw the finality outstanding Office Action.

In view of the following remarks Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Objection to the Specification

First, the Examiner has objected to the disclosure asserting that the anti-static layer (26) is not shown in Figure 1. Attached hereto Applicants provide a red-lined version of Figure 1. This red-line version includes an anti-static layer (26) on the uncoated side of the support (21). This proposed drawing change is supported by the present specification at page 29, lines 15-16. The Examiner is respectfully requested to approve the red-lined version of the drawings. Upon approval, Applicants will submit formal copies of this drawing.

*Accepted*

Second, the Examiner asserts that the amendment filed on August 14, 2002 introduces "new matter" into the specification and is therefore in violation of 35 U.S.C. §132. Applicants respectfully traverse this "objection". The introduction of the language "alternatively" or "or alternatively" does not change the scope of the specification. The Examiner has read this amendment in a vacuum without giving due credit to the entire

*No peeling required*

specification. Applicants simply amended the specification at pages 51 and 52 to indicate that alternative methods of transferring the label exist. It is not always necessary to peel the label from the support prior to transferring. Also, heating may be applied from either the front or the back of the receptor. The Examiner is respectfully requested to refer to the present specification at page 4, lines 3-19 as well as page 6, lines 17-26. For instance, the description at page 6 indicates that the high temperature at which the present polymer layers melt make them suitable for laser printers and copiers. This embodiment makes no mention of peeling the label away from the support prior to transfer. Thus, the description at pages 51 and 52 has been amended to be consistent, for instance, with this alternative embodiment.

*not related to peeling procedure*

Moreover, further support for the "alternative" language may be found on page 52, lines 3-13 of the specification. There is no need to use an optional sheet on the front of the label if heat is applied from the back of the label. The optional sheet of paper or protective film is only necessary if the heating appliance (e.g. iron) will stick to the face of the imaged label.

Under these circumstances, the optional sheet of paper or protective film is necessary.

Accordingly, the Examiner is respectfully requested to withdraw this objection.

*incorrect*

Issues Under 35 U.S.C. §112, second paragraph

The Examiner appears to have maintained the rejection of claims 1-45 and 58-62 under 35 U.S.C. §112, second paragraph. Applicants traverse each of these rejections.

First, the Examiner continues to assert that it is necessary to specify the order of layers. The Examiner asserts that without the recitation of such layers the claim is unduly broad and therefore possibly in violation of 112, first paragraph. Applicants traverse this rejection. Applicants submit that it is unnecessary to specify a layer of orders. The second paragraph of 35 U.S.C. §112, requires that the claims particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Nowhere within the statute is there an explicit recitation that the scope of the claim, whether it is broad or narrow, adversely effects the distinctness of the claimed subject matter. Furthermore, the MPEP states:

OK  
Still  
Vague,  
indefinite

"Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph." (see MPEP 2173.04).

As such, Applicants respectfully submit that the rejections under 35 U.S.C. §112, second paragraph with respect to the "order

of layers" being unduly broad is improper and should be withdrawn.

Second, the Examiner continues to argue that the "copolymer" defined in claim 1 must be further specified since it is unduly broad. Applicants traverse. As explained previously, the copolymers are defined by way of functionality. Moreover, as discussed above, the breadth of the claim has no bearing within 35 U.S.C. §112, second paragraph. Accordingly, this rejection is improper and should be withdrawn. OK

Third, the Examiner asserts that newly amended claim 1, limitation (ii), appears to have a narrower scope with respect to the Tg limitation (less than 0°C) placed in each Markush member.

Applicants submit that the claim has not been narrowed since such language was always included with respect to each member. For instance, prior to the previous amendment the claim read "said polyester, acrylic polymer or copolymer blend having a glass transition temperature (Tg) of less than 0°C". As such, the limitation concerning the glass transition temperature was applicable to each of the polyester, acrylic polymer and copolymer. Thus, the Examiner is incorrect in asserting that the claim has been narrowed. Regardless, the Examiner has provided no basis for this amendment being indefinite.

Fourth, the Examiner asserts that newly amended claim 1, limitation (iii), line 1 recites "at least in addition to the

Markush language". The Examiner asserts that this results in a broader claim. Applicants point out that the Examiner has provided no basis in this rejection as to why a broader claim would be indefinite. However, the Examiner is wrong in his assertion. In particular, the claim language always included "combinations", thus the language relating to "at least one" is consistent with such language.

Applicants respectfully submit that the present claims fully satisfy the requirements of 35 U.S.C. §112, second paragraph. Accordingly, the Examiner is respectfully requested to withdraw these rejections.

Issues Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-45 and 58-62 under 35 U.S.C. §103(a) as being obvious over Meyer, USP 3,595,739 (hereinafter referred to as Meyer '739) in view of Kronzer, USP 5,798,179 (hereinafter referred to as Kronzer '179). Applicants respectfully traverse this rejection.

First, Applicants take strong issue with the Examiner's continued reliance upon "official notice" as a basis for rejecting elements of the claims. The Examiner has made no attempt to provide references would presumably exist if such elements were "common knowledge." Applicants direct the Examiner's attention to MPEP §2144.03(A) which states "while

'Official Notice' may be relied on, these circumstances should be rare when an application is under final rejection." The present application is under final rejection. Moreover, even if the Examiner has properly taken "official notice", there must be some form of evidence on the record to support such an assertion of common knowledge. In this regard the Examiner is respectfully requested to refer to *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specifying factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection).

Also, now that Applicants have challenged the Examiner's assertion of official notice. The Examiner must now provide documentary evidence if the rejection is to be maintained. In this regard, the Examiner is requested to refer to 37 C.F.R. §1.104(c)(2) and *Zurko*, 59 USPQ2d at 1697.

Alternatively, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, the Examiner is respectfully requested to provide an affidavit or declaration setting forth specific factual statements and explanations to support such a finding. In this regard the Examiner is referred to 37 C.F.R. §1.104(d)(2).

Second, even assuming, *arguendo*, that the Examiner has

properly taken official notice, a point not conceded by Applicants, the Examiner's rejection still fails to satisfy the requirements of 35 U.S.C. §103(a). The Examiner has utilized the primary reference of Meyers '379 and the secondary reference of Kronzer '179. No motivation exists to combine these two references as suggested by the Examiner. That is, the material described in Meyer '739 is completely different from the material described in Kronzer '179. For instance, the material described in Meyers '739 does not include an adhesive layer which is capable of being removed from the support without heat (as currently claimed). This is not surprising, since, Meyers '739 specifically discloses that removing the support is inconsistent with the invention of Meyers '739. In this regard the Examiner is referred to column 1, line 63 to column 2, line 5 of Meyers '739. Applicants have provided this disclosure below for the Examiner's convenience.

The present invention is directed to a label or like marking device which offers substantially all the advantages of heat transfers produced according to the above-noted patent but which can be more economically produced and which has the further important advantage that the time cycle required for applying or bonding the marking to the article to be marked can in many cases be reduced as compared with the procedure involved in the above-noted patent, while, furthermore, **the step of removing the temporary support can be avoided** which results in a saving of time. (emphasis added).

Moreover, at column 2, lines 14-16 of Meyers '739 it is

disclosed that

With such a marking element the support remains bonded to the surface and carries a marking or decorative pattern on the exposed surface.

Thus, the "cold releasable" adhesives which the Examiner takes official notice to be well known in the art are inconsistent with Meyers '739, since Meyers '739 never intends to remove the support from the article. Accordingly, the limitations of "pressure sensitive adhesive layer" and "adhesion layer" claimed in the present claims, for instance claim 1 are neither suggested nor disclosed with Meyers '739. Moreover, ignoring the fact that the Examiner has selected elements of Kronzer '179 while ignoring other elements (a procedure improper within the scope of 35 U.S.C. §103(a)), one of ordinary skill in the art would find no motivation to modify Meyer as suggested by the Examiner, since Meyer clearly indicates that the support is to remain bonded to the surface of the article. Thus, the limitation of "wherein the adhesive layer is capable of being removed from the support without heat" is neither suggested nor disclosed by Meyers '739.

Moreover, it would destroy the teachings of Meyers '739 to modify the reference in the way suggested by the Examiner. Specifically, Meyer states at column 2, lines 3-5 that the step of removing the temporary support is to be avoided. Where references expressly teach away from what the PTO contends to be

obvious from the references (*In re Grasseli et al.* (CAFC 1983) 713 F.2d 731, 218 USPQ 769) or where the Examiner's proposed modification would render the prior art unsatisfactory for its intended purpose, there is insufficient evidence for combining the references in a 103(a) rejection. *Ex parte Rosenfeld* 130 USPQ 113 (POBA 1961); accord, *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Accordingly, the Examiner has failed to present a valid *prima facie* case of obviousness, thus, this rejection is moot. Reconsideration and withdrawal thereof are respectfully requested.

In summary, Applicants respectfully submit that all currently pending claims are in condition for allowance. The Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please contact the undersigned at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17;  
particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By \_\_\_\_\_



Marc S. Weiner  
Reg. No. 32,181

Post Office Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

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Enclosure: Red-lined version of Figure 1



Fig. 1

